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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,721	12/28/2001	Huijuan D. Chen	83710D-W	2122

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 06/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/034,721	CHEN ET AL.
	Examiner Helene Klemanski	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
  - 2a) This action is **FINAL**.                    2b) This action is non-final.
  - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-21 is/are pending in the application.
    - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 1-21 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Specification***

1. The disclosure is objected to because of the following informalities: on page 1, the serial numbers of the copending applications should be inserted and on page 9, the phrase “COLOR INDEX” should be replaced with the phrase “Color Index”.

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: no literal antecedent basis is seen for the phrases:

- (1) “wherein said at least two color inks are selected from white” in claim 4;
- (2) “wherein said pigment comprises particles less than 0.5 micron in size” in claim 5;
- (3) “wherein the inorganic particles comprise zirconia” in claim 14 (see page 13, lines 20-25 of the specification);
- (4) “wherein the organic polymeric particles comprise a polyurethane, a polyacrylic, or a polyester” in claim 17 (see page 13, lines 20-25 of the specification) and
- (5) “wherein the film forming polymer resin is a sulfonated polyester ionomer” in claim 20 (applicants disclose on page 13, line of the specification that the film forming polymer is a polyester ionomer but does not disclose that it is sulfonated).

The examiner suggests the incorporation of this phrase into the specification or the claims amended accordingly.

### ***Double Patenting***

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3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/034281. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/032931. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20 of copending Application No. 10/034285. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/033229. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 18, 19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Erdtmann et al.

Erdtmann et al. teach an ink jet ink set comprising a cyan ink, a magenta ink, a yellow ink and optionally a black ink. Each ink composition comprises a pigment, a dispersant such as an acrylic polymer and a carrier such as water. The cyan ink comprises Pigment Blue 15:3 as the pigment; the magenta ink comprises Pigment Red 122 as the pigment and the yellow ink comprises Pigment Yellow 74 or Pigment Yellow 155. See the abstract, col. 1, lines 45-52, col. 2, lines 3-15, col. 3, lines 54-57, col. 4, lines 48-60, Ink 2-5 and claims 1-3 and 6. The ink jet ink set as taught by Erdtmann et al. appears to anticipate the present claims.

6. Claims 1-9, 18, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al.

Walker et al. teach an ink jet ink set comprising a cyan ink, a magenta ink, a yellow ink, a green ink, an orange ink and a black ink. Each ink composition comprises a pigment, a dispersant such as an acrylic polymer and a carrier such as water. The cyan ink comprises Pigment Blue 15:3 as the pigment; the magenta ink comprises Pigment Red 122 as the pigment and the yellow ink comprises Pigment Yellow 155. See the abstract, col. 2, lines 25-67, col. 3, lines 7-10, col. 4, lines 12-52, Example 1, Table 1 and claims 1, 3, 4, 10 and 14. The ink jet ink set as taught by Walker et al. appears to anticipate the present claims.

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7. Claims 1-9, 18, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Oyanagi.

Oyanagi teach an ink jet ink set comprising a cyan ink, a magenta ink, a yellow ink and optionally a black ink. Each ink composition comprises a pigment, a dispersant such as an acrylic polymer and a carrier such as water. The cyan ink comprises Pigment Blue 15:3 as the pigment; the magenta ink comprises Pigment Red 122 as the pigment and the yellow ink comprises Pigment Yellow 74. See col. 7, lines 21-25 and example 1. The ink jet ink set as taught by Oyanagi appears to anticipate the present claims.

The only limitation in the claims not found by the examiner is the Relative Gloss Variability. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain a color pigment ink set with applicants claimed Relative Gloss Variability since the pigment set is the same pigment set as claimed by applicants (see claims 7-9).

### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is 703-308-3745. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
June 16, 2003